

REMARKS

Applicant requests favorable reconsideration and withdrawal of the objections and rejections set forth in the outstanding Office Action in view of the foregoing amendments and the following remarks.

Initially, the Office Action objects to the Specification of the present application. The Office Action cites 37 C.F.R. § 1.52(b)(2)(ii) for the requirements of the text of an application. The Office Action then asserts that the Specification, Abstract, and Claims of the present application utilize a font size of at least 17, and notes that a font size of 12 is preferred.

Applicant respectfully traverses this objection. The present application was filed using the U.S. Patent & Trademarks Office's (USPTO) electronic filing system, which was in place at the time of filing. Accordingly, Applicant filed the application in the format required at the time by the USPTO, in order to use the USPTO's own system.

Applicant further traverses this objection on the grounds that there is no rule with respect to the maximum size of font allowable in an application. Instead, 37 C.F.R. § 1.52(b)(2)(ii), for example, merely sets forth minimum size requirements for fonts. Moreover, Applicant submits that the USPTO cannot assert that the copy of the application is illegible, as the USPTO was successfully able to publish the application. See U.S. Patent Application Pub. No. 2005/0177503 A1.

For these reasons, it is unnecessary for Applicant to bear the time and expense of preparing new copies of the Specification, Abstract, and Claims, and there is no basis for the USPTO to require such documents. Accordingly, Applicant requests the objection be withdrawn.

Claims 1-7, 9, and 11-13 are now pending, with claim 1 being independent. Claims 8 and 10 have been cancelled without prejudice or disclaimer of subject matter. Claims 1-7, 9, 11, and 12 has been amended herein. Claim 13 is new. Support for the amendments and new claim can be found throughout the originally-filed disclosure, including, for example, the original claims, and at paragraph [0053] of the Specification. Thus, Applicant submits the amendments and new claim include no new matter.

The Office Action objects to the claim numbering for not using Arabic numerals. Applicant notes that the claim numbering in the originally-filed claims was the result of the formatting per the requirements of USPTO's electronic filing system in place at the time of filing (discussed above). In any event, the claim listing herein uses Arabic numerals, and, accordingly, Applicant submits this objection should be withdrawn.

Claims 8-10 are objected to under 37 C.F.R. § 1.75(c), as being of improper dependent form for failing to further limit the subject matter of the previous claim. In support of this objection, the Office Action asserts that it is unclear how obtaining information related to user loyalty points further limits acquiring user income, as is recited in the claims.

In response, Applicant notes that claims 8 and 10 have been cancelled herein, thereby rendering the objection to these claims moot. Applicant additionally notes that claim 9 has been amended herein, and, Applicant submits that the language of claim 9 clearly further defines the features recited in claim 1. Accordingly, Applicant submits that claim 9 is a proper dependent claim. Applicant further respectively traverses the objection, however, with respect to the language the Office Action indicates is objectionable. Specifically, Applicant notes that claim 8, when read in context, recited that information related to user loyalty points was

obtained, and the loyalty points were converted to a currency value. The currency value, in turn, constituted user income, and, hence, the acquiring of the loyalty point information was part of the acquiring user income step. Therefore, claim 8, and, similarly, claims 9 and 10, clearly further defined the acquiring user income step of claim 1.

Claim 1 is provisionally rejected in the Office Action on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claim 13 of co-pending Application No. 10/709,701 (hereinafter “the ‘701 Application”).

Applicant respectfully traverses this rejection. Nevertheless, as described more fully below, claim 1 of the present application has been amended to further clarify that the step of acquiring user income includes obtaining information related to user loyalty points and converting the user loyalty points to a currency value. Applicant submits the claims of the ‘701 Application fail to teach or suggest at least this feature of claim 1. Accordingly, Applicant submits the double patenting rejection has been overcome and should be withdrawn.

Claims 3-5 are rejected in the Office Action under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the Office Action alleges that the terms “substantially” and “substantial,” as used in these claims, are relative terms, which thereby render the claims indefinite. The Office Action implies that precise numerical values are necessary for one of ordinary skill in the art to ascertain the terms “substantially equal” and “substantial compliance,” as used in these claims.

Applicant respectfully traverse this rejection. The term “substantially” has been found by the Federal Circuit to be a definite, and satisfy the requirements of 35 U.S.C. § 112. *Verve, LLC v. Crane Cams, Inc.*, 311 F.3d 1116, 1120, 65 USPQ2d 1051, 1054 (Fed. Cir. 2002). In

particular, the court has noted that “[e]xpressions such as ‘substantially’ are used in patent documents when warranted by the nature of the invention, in order to accommodate the minor variations that may be appropriate to secure the invention. Such usage may well satisfy the charge to ‘particularly point out and distinctly claim’ the invention, 35 U.S.C. § 112, and indeed may be necessary in order to provide the inventor with the benefit of his invention.” *Id.* Thus, the court has made it clear that an inventor need not specifically limit his invention to precise numerical values, but rather may use the relative term “substantially,” so long as one of ordinary skill in the art would understand the invention. In this case, Applicant submits that the usage of the terms “substantially equal” and “substantial compliance” in the claims would be sufficiently clear to be understood by persons in the field of invention, without further reference to specific numerical values.

The Office Action further rejects claim 12 under 35 U.S.C. § 112, noting that the term “said system,” does not have an antecedent basis.

In response, Applicant has amended claim 12, so as to deleted the reference to a system. Accordingly, Applicant submits this rejection has been obviated.

The Office Action rejects claim 1 as being anticipated by VanLeeuwen (U.S. Patent No. 2002/0123949). The Office Action further rejects claims 2-7 under 35 U.S.C. § 103(a) as being unpatentable over VanLeeuwen in view of Ogilvie (U.S. Patent No. 6,631,358). The Office Action still furhter rejects claims 8-12 under 35 U.S.C. § 103(a) as being unpatentable over VanLeeuwen in view of Postrel (U.S. Patent No. 6,594,640).

Applicant respectfully traverses the rejections. Nevertheless, without conceding the propriety of the rejections and solely to expedite prosecution, Applicant has amended

independent claim 1 to clarify distinctions between the claim and the cited references.

Applicant submits amended claim 1 is allowable, for at least the following reasons.

In discussing previously pending claim 10, the Office Action acknowledges that

VanLeeuwen does not disclose obtaining information related to user loyalty points, converting the loyalty points to a currency value, and applying the currency value to at least one of a user savings account and user debts. However, the Office Action cites Postrel as suggesting exchanging reward points for monetary credit, and asserts that VanLeeuwen contemplates applying cash value to either debt reduction or another future fund specified the user.

Applicant respectfully submits, however, that independent claim 1, which now includes some of the features previously recited in claim 10, would not have been obvious to one of ordinary skill in the art in view of the collective teachings of VanLeeuwen and Postrel.

In Applicant's view, Postrel only contemplates using "reward points" for purchasing items from a merchant. See, e.g., Postrel, col. 4, lines 30-44; col. 7, lines 33-41. Nothing in Postrel suggests using reward point for any purpose other than purchasing merchandise, let alone specifically using the reward points in a method of allocating income so as to apply a currency value of the points to a user savings account, as recited in claim 1 of the present application.

Applicant, therefore, submits there is no basis to conclude one that one of ordinary skill in the art in view of VanLeeuwen (which itself discloses nothing of loyalty or reward points), would look to Postrel's disclosure of using reward points to pay for merchandise, abstract the idea of reward points for use with the disclosure of VanLeeuwen, and yet ignore Postrel's express and repeated teaching of using the points to pay for merchandise. In other words, even

if VanLeeuwen and Postrel are taken collectively, the references still fail to suggest “obtaining information related to user loyalty points, converting [the] user loyalty points to a currency value, and applying [the] currency value to [a] user savings account,” as recited in independent claim 1 of the present application.

Applicant further submits that given the lack of disclosure and suggestion of all the features of amended independent claim 1 in the collective teachings of VanLeeuwen and Postrel, and given the express teaching of different application of the reward points by Postrel, that there is no basis to assume one of ordinary skill in the art would combine the teachings of VanLeeuwen and Postrel and derive Applicant’s invention recited in claim 1, absent impermissible hindsight of the present application. Accordingly, Applicant submits that independent claim 1 is allowable over the combination of VanLeeuwen and Postrel.

Applicant further submits the citation to Ogilvie fails to cure the above-noted deficiencies of VanLeeuwen and Postrel. For example, Ogilvie fails to disclose or suggest anything analogous to loyalty points. Accordingly, VanLeeuwen, Postrel, and Ogilvie, whether taken individually or collectively, fail to teach or suggest Applicant’s invention, as recited in claim 1.

The other claims are allowable by virtue of their dependency and in their own right further defining the invention. Individual consideration of the dependent claims is respectfully requested.

Applicant respectfully submits that all of the pending claims are allowable over the references of record, and that the application is in condition for allowance. Favorable

reconsideration, withdrawal of the outstanding objections and rejections, and passage to issue of the present application are earnestly solicited.

Applicant's undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our New York office at the address shown below.

Respectfully submitted,

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